



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

Y.K. Chen 28-19-3-3

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 23 August 2007

Signature

Typed or printed
name

John F. McCabe

Application Number

10/624,038

Filed

07/21/2003

First Named Inventor

Young-Kai Chen et al

Art Unit

2815

Examiner

Richards, N Drew

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 42,854☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

John F. McCabe

Typed or printed name

908-582-6866

Telephone number

23 August 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**ARGUMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

At page 2, the Final Office Action rejects claims 8, 10, 12 – 14, 16, 22, and 25 as anticipated by U.S. Patent 5,506,427 of Imai (Herein, referred to as Imai.).

The Office Action relies on Fig. 1H to reject pending independent claim 8. To better explain the anticipation rejection, Applicants reproduce below Imai's Figure 1H.

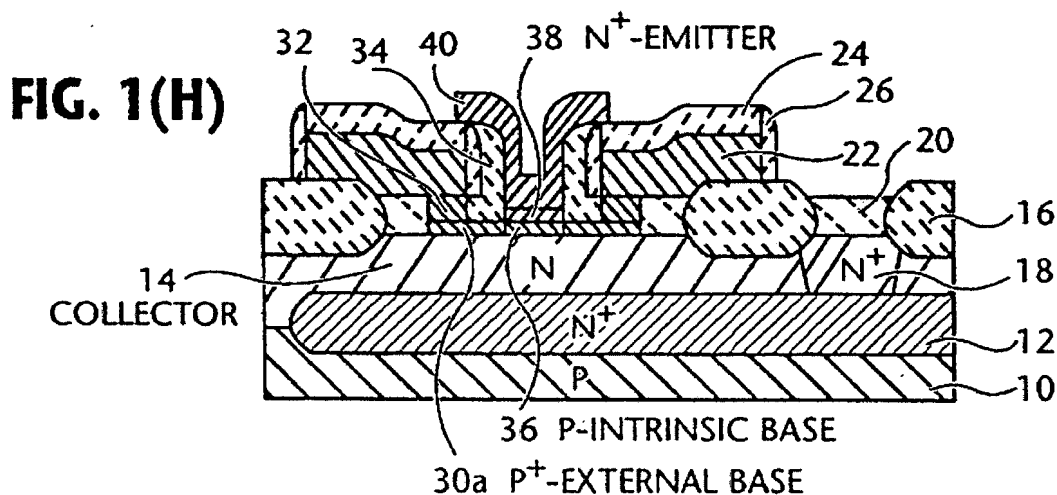


Figure 1H shows layer 18 as being located to the side of layer 14 and also identifies layer 14 as being the collector. That is, Imai does not show layer 18 as being below the collector 14.

At page 3 line 1, and page 6, lines 12 – 13, the Office Action states that Imai's layer 18 teaches the subcollector as recited in the pending claim 8. In response, Applicants note that the word "subcollector" is a descriptive term. In particular, subcollector includes the prefix "sub", and "sub" means "below". For that reason, it is evident that the word subcollector refers to a feature or layer that is located below the collector.

Whereas the Office Action cites Imai's layer 18 as teaching the subcollector of pending claim 8, Imai's layer 18 is not located below Imai's collector layer 14. Instead, Imai's Fig. 1H shows the layer 18 as being located to the side of the collector layer 14. For that reason, Imai's layer 18 is not a subcollector. Thus, the Office Action does not cite a proper prior art teaching for the subcollector recited in pending claim 8. For this reason, the rejection of the Office Action is improper and should be withdrawn.

In addition, Applicants mention that the n^+ -type buried layer 12 of Imai does not meet the limitations that pending claim 8 recites for its subcollector. In particular, Imai's Fig. 1H shows the layer 12 as extending below each part 36 and 30a of the base layer. In contrast pending claim 8 recites:

wherein the substrate includes a subcollector that forms an electrical contact for the collector layer, the entire subcollector being located outside of the portion of the substrate that is vertically below part of the base layer.

(underlining added).

Since Fig. 1H shows layer 12 below each part of the base layer 36, Imai does not suggest that the entire subcollector is outside of the portion of the substrate that is vertically below some part of the base layer as recited in pending claim 8. Thus, even if the Examiner had identified Imai's layer 12 as the subcollector, the cited parts of Imai would not teach the specific type of subcollector recited in pending claim 8.

For both of the above-stated reasons, the Office Action has not provided a proper rejection of claim 8, and the novelty rejection should be withdrawn.

Claims 10, 12 – 14, 16, 22, and 25

Claims 10, 12 – 14, 16, 22, and 25 are novel over Imai as applied in the Office Action, at least, by their dependence on pending claim 8.

At page 4, the Office Action rejects claim 17 as obvious over a combination of Imai and U.S. Patent 5,444,003 of Wang et al (Herein, referred to as Wang.).

Claim 17 is non-obvious over the above combination as applied in the Office Action, at least, by its dependence on pending claim 8.

At page 4, the Office Action rejects claims 18 – 19 and 29 – 30 as obvious over a combination of Imai and U.S. Patent 6,541,346 of Malik (Herein, referred to as Malik.).

Claims 18 – 19 and 29 – 30 are non-obvious over the above combination as applied in the Office Action, at least, by their dependence on pending claim 8.

At page 5, the Office Action rejects claim 31 as obvious over a combination of Imai, Malik, and U.S. Patent 5,096,844 of Konig et al (Herein, referred to as Konig.).

Claim 31 is non-obvious over the above combination as applied in the Office Action, at least, by its dependence on pending claim 8.

CONCLUSIONS

Applicants request allowance of claims 8, 10, 12 – 14, 16 – 19, 22, 25, and 29 – 31 as presented herein.

Respectfully,



John F. McCabe, Attorney Reg. No. 42,854
Tel: 908-582-6866.

Date: Aug. 23, 2007
Alcatel-Lucent
Docket Administrator, Room 2F-190
600-700 Mountain Avenue
Murray Hill, NJ 07974-0636